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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/135,504 06/22/98 IGBINADOLOR

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LM02/0720

EXAMINER

GRANT, C

ART UNIT

PAPER NUMBER

2711

16

DATE MAILED:

07/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/135,504

Applicant(s)
IGBINADOLOR

Examiner
Christopher Grant

Group Art Unit
2711



☒ Responsive to communication(s) filed on Oct 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Status of Application

1. Applicant's application cannot be allowed (i.e. cannot be patented) at this time because of the following:

- (i) a statement that the substitute specification contains **no new matter** was not mentioned in applicant's response; and
- (ii) the marked-up copy provided by applicant is defective as described below.
- (iii) the claims are vague and/or indefinite.

Mr. Phillip Igbinadolor was instructed to submit the mark-up copy by taking a copy of the substitute specification and indicate in pen the location of the substitute specification subject matter relative to the originally filed specification subject matter. In other words, applicant should indicate on a copy of the substitute specification in pen, the page and line number of the corresponding subject matter in the originally filed specification.

Applicant's application fails to meet the legal requirements of 35 United States Code (USC). A copy of the relevant patent law sections (e.g. 35 USC 112) was mailed to applicant 2/1/00.

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Additionally, applicant's application has formal defects governed by 37 Code of Federal Regulations (CFR). Copies of all the relevant sections of 37 CFR that are cited were provided to applicant on 2/1/00.

Defects under 35 USC are very serious and must be overcome. Deficiencies under 37 CFR are less serious, but applicant must still overcome them. The examiner if needed, can assist applicant in fulfilling the requirements of 37 CFR.

Specification

2. The amendment filed 10/19/99 is rejected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows (only a few examples are listed):

- a) On page 1, lines 9-10 **"audio and video in analog or digital"**.
- b) On page 4, line 6, **"...and home entertainment audio/video"**.
- c) On page 4, lines 10-13, **"nine dubbing sequences tape to tape.....memory to memory within and between the cassette and disk deck"**.
- d) On page 4, line 14 **"home and commercial entertainment center version"**.
- e) On page 4, lines 15-16, **"the system records and plays all features claimed, has an external input port for a personal computer"**
- f) On page 5, line 6, **"fiber optical images"**.

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Applicant is required to review the entire substitute specification and cancel the new matter in reply to this Office action.

If applicant contends that the substitute specification does not contain any new subject matter, then applicant must re-submit a new mark-up copy (*indicating the page and line number of the corresponding subject matter in the originally filed specification*) for review by the examiner.

3. The substitute specification filed 10/19/99 has not been entered because it does not conform to 37 CFR 1.125(b) because:

a) the statement as to a lack of new matter under 37 CFR is missing.

b) the marked-up copy does not clearly show the matter being added to and the matter being deleted. Applicant's markup copy is defective because the relationship between the underlined subject matter and the original specification is not clear. Further, it is not clear what specific subject matter is being referred to by some of the pen written page and line numbers.

4. A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because the arrangement and content are not in compliance with MPEP 608.01 (a).

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute

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specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains **no new matter**; and 2) **a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.**

5. Although the application is not totally informal, the arrangement of the specification is listed below for applicant's convenience. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

6. Applicant is advised on how to arrange the content of the specification.

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Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

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- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet. (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.
- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing: See 37 CFR 1.821-1.825.

Drawings

7. The drawings are objected to because of the following:

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a) Figures 8-12 have numerous and/or cumbersome hand written information which are difficult to read.

8. Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A *separate* letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and *may not be deferred*.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to

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enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

10. The specification is objected to under 37 CFR 1.71 because the description of the invention appears to be incomplete and/or not clear. The current invention is generally an audio/video car dubbing system. However the specification fails to point out how audio or video is transferred from one medium to another. Applicant's current disclosure (specification and drawings) lists or catalogs the various items that are found in the system, but it fails to specify how the car dubbing system actually works or functions.

11. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

12. Claims 1-8 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

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The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

For example:

- a) Claim 1 recites the limitation "**the seven functional components**" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.
- b) Claim 1 is vague because the phrase "**as illustrated on figures 1, 8, 20 and 21**" in line 6 appears to be referring back to the drawing figures. Note that (1) a claim can only refer back to a previous claim and (2) all reference characters must be in parenthesis {for example: cd player (29) of cited patent 5,797,088. Here "29" are the reference characters}.
- c) Claim 2 recites the limitation "**each unitary deck to record, store, and playback**" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
- d) Claim 2 is vague because the phrase "**as shown on Figure 9**" (line 2) and "**as shown on Figure 14**" (line 6) are referring back to drawing figures which is not allowed in a claim. See item b above for explanation.

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e) Claim 2 is vague and/or incomplete because the last line (line 8) ends with the phrase “; and”.

Note that MPEP 608.01 (m) requires that a claim ends with a period.

f) Claim 3 is vague because the phrase “**see Figure 15 for illustration**” (line 6) and “**as shown on Figure 17**” are referring back to drawing figures which are not allowed in a claim. See item b above for explanation.

g) Claim 3 is vague and/or incomplete because the last line (line 8) ends with the phrase “; and”.

Note that MPEP 608.01 (m) requires that a claim ends with a period.

h) Claims 4-8 are accordingly rejected for similiar reasons as described above in the rejection of claims 1-3. Correction is required.

13. Applicant should note that there is no art rejection because the claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All statutes (35 USC) and rules 37 CFR are provided on the PTO web site at www.uspto.gov.

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Conclusion

14. It is called to applicant's attention that if a communication is deposited with the U. S. Postal Service and mailed to the Office by First Class Mail before the reply time has expired, applicant may submit the reply with a "Certificate of Mailing" which merely asserts that the reply is being mailed on a given date. So mailed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

Assistant Commissioner for Patents

Washington, D.C. 20231

on _____(date).

Typed or printed name of person signing this certificate

Signature_____

Date_____

15. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

16. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rines et al. disclose a car radio apparatus comprising a recording device, a playback device and a wireless receiving circuitry.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 3900.



Chris Grant
Primary Examiner
July 18, 2000